

REMARKS

Claims 1-6, all the claims pending in the application, stand rejected. Claim 2 is amended.

Claim Objections

Claim 2 is objected to because of a typographical error. At line 9, Applicant has corrected the spelling of “allowing.”

Claim Rejections - 35 USC § 112

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

This rejection is traversed for at least the following reasons.

The Examiner observes that Applicant claims states that the device is bent "like a bow." The Examiner asserts that “it is unclear to what the applicant is trying to claim as the language like a bow is vague as there are many kinds of bows.”

First, Applicant respectfully submits that the claims are to be interpreted in light of the specification. The original specification expressly states at page 6 that the invention is “A portable shoehorn 1 (refer to FIGS. 1A and 1B) is a shoehorn obtained by bending a plate member, which has been bend in a breadth direction thereof, in a longitudinal direction thereof approximately lien [sic “like”]a bow to form a slender plate shape...” Also, at page 9, the original application states “Then, when the portable shoehorn 1 carried in a folded state is used, any one of the backscratcher 2 and the shoehorn portion 1b of the shoehorn is rotated for opening such that both the backscratcher 2 and the shoehorn portion 1b are made into a state like a slender plate, as shown in FIG. 1, which is bent approximately like a bow.”

Second, the description and the claims expressly state that the bow shape forms “a slender plate shape.” Figure 1(b) makes this textual description absolutely clear.

The Examiner asserts that there are many types of bows. However, this broad statement is unfounded. First, the claim expressly refers to a bow shape that has a slender plate shape. Second, given the examples and the principles of law applicable to interpretation, such other types of bows would not be included unless a court found that they were within the meaning supported by the original disclosure. Finally, Applicants respectfully note that the Examiner is not confused by the term “bow,” as he applies the prior art against this structure without reservation.

The term “bow” approximating a “plate shape” as used in the claims is abundantly clear and the rejection should be withdrawn.

Claim Rejections - 35 USC § 103

Claims 1 and 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wedermeyer (US D208,894) in view of Fong (US 5,185,902). This rejection is traversed for at least the following reasons.

Wedermeyer

The Examiner asserts that Wedermeyer teaches a portable shoehorn with the shoehorn portion having “a shape like a bow” with a backscratcher located at the opposite distal end. The Examiner further asserts that the combined back scratcher and shoe horn has “an elastic body (the handle) removable via the holding pins to either the shoehorn or backscratcher portions.”

First, the Examiner's assumption is not supported by any disclosure in Wedermeyer. Nothing teaches that there are removeable parts. Indeed, Wedermeyer is a design patent that is limited to "ornamental designs", as expressly stated in the claim. There is no teaching of removeability of any part.

Second, the Examiner does correctly state that Wedermeyer does not teach the handle portion being capable of folding.

Third, there is no "elastic body for patting a human body is constituted so as to be removeably mounted to a portion of the backscratcher and a shoehorn portion of the shoehorn."

In sum, Wedermeyer is merely one long straight shaft shaped at opposite ends with a back scratcher and a shoe horn, and an elastic body for patting a user. No other structural features as claimed are present. There is no teaching or suggestion of removeability.

Fong

In order to remedy the deficiencies of Wedermeyer, the Examiner looks to Fong for a teaching of a combination shoehorn and brush having a folding handle that folds is half at 231. The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the teachings of Wedermeyer with Fong to reduce the overall length of the device.

First, there is no teaching of removeability in either reference. Thus, this expressly claimed feature is not in the prior art.

Second, the brush in Fong does not have a shape "in a longitudinal direction thereof approximately like a bow to form a slender plate shape," as claimed.

Third, there is no “elastic body for patting a human body is constituted so as to be removeably mounted to a portion of the backscratcher and a shoehorn portion of the shoehorn.” Indeed, the Examiner does not even mention this limitation, and perhaps it has been overlooked in the analysis.

Allowable Subject Matter

The Examiner asserts that claims 2 and 5-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Applicants have amended claim 2 to place it into independent form.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Alan J. Kasper/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Alan J. Kasper
Registration No. 25,426

Date: March 26, 2008